

REMARKS

In view of the above amendments and the following remarks, reconsideration and allowance of this application are respectfully requested. Claims 1-4, 8-12, and 21-37 are pending in this case, with claims 1, 11, 23, and 29 being independent. Claims 1, 2, 4, 11, 29, and 35 have been amended, claims 5, 7, 13, 14, 16, have been cancelled, and claim 37 has been added. Applicant submits that the amendments and new claim is supported at least by figure 3 and the associated description of figure 3 at pages 3-4. No new matter has been added.

Claim 23

The Office Action rejects independent claim 23 as obvious over U.S. Patent No. 3,368,814 (Kolwicz) in view of U.S. Patent No. 5,769,424 (Kelly), and further in view of U.S. Patent No. 5,031,919 (Dixon). Independent claim 23 is directed to a game that includes a base unit. A target area is attached to the base unit and has multiple target sections. Each target section includes an aperture. A launch area also is attached to the base unit. The launch area is configured such that a playing piece tossed onto the launch area bounces into one of the multiple target sections and passes through the corresponding aperture of the target section. At least one sensor is configured to detect when a playing piece passes through one of the apertures. The game also includes an input and an electronic controller. The input is configured to allow a player to select one of at least two game modes. Each of the two game modes has a different objective for game play. The electronic controller is operatively connected to the input and the sensor to control game play according to a game mode selected by the player.

Applicant respectfully requests that this rejection be withdrawn because the Office Action fails to establish a *prima facie* case of obviousness for at least two reasons. First, the Office Action fails to provide a motivation to combine Kolwicz, Kelly, and Dixon. Second, Kolwicz, Kelly, and Dixon do not describe or suggest each feature of claim 23.

In rejecting claim 23, the Office Action asserts that:

Applicant has done no more than to select features from the prior art and incorporate them into a unitary feature without materially altering the structure or function of each individual feature and without producing any new or unexpected result. To select features from the prior art to effect results expected from these features is within the purview of 35 USC 103.

This is simply an incorrect statement of the requirements of 35 USC 103. Applicant is not required to materially alter the structure or function of each individual feature, or to produce new or unexpected results. Nor can the Examiner simply use the claim as a blueprint to piece together elements in the prior art to make a rejection of the claim. Specifically, as stated by the Court of Appeals for the Federal Circuit:

[V]irtually all [inventions] are combinations of old elements. Therefore an examiner may often find every element of a claimed invention in the prior art. If identification of each claimed element in the prior art were sufficient to negate patentability, very few patents would ever issue. Furthermore, rejecting patents solely by finding prior art corollaries for the claimed elements would permit an examiner to use the claimed invention itself as a blueprint for piecing together elements in the prior art to defeat the patentability of the claimed invention. Such an approach would be an illogical and inappropriate process by which to determine patentability.

To prevent the use of hindsight based on the invention to defeat patentability of the invention, this court requires the examiner to show a motivation to combine the references that create the case of obviousness.

In re Rouffet, 149 F.3d 1350, 1357 (Fed. Cir. 1998) (internal citations and quotation marks omitted)

Accordingly, to establish a *prima facie* case of obviousness, “there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings.” MPEP 2143 In addition, “the prior art reference (or references when combined) must teach or suggest all the claim limitations.” *Id.*

The rejection of claim 23 fails to satisfy these requirements for establishing a *prima facie* case of obvious.

With respect to the first requirement, the Office Action does not provide a motivation to combine Kolwicz, Kelly, and Dixon, even though “it is the duty of the Examiner to explain why

combination of the reference teachings is proper.” *Ex parte Skinner*, 2 U.S.P.Q.2d 1788, 1790 (B.P.A.I. 1987).

With respect to the second requirement, Kolwicz and Kelly do not disclose or suggest at least “an input that allows a player to select one of at least two game modes, wherein each of the two game modes has a different objective for game play,” as recited in claim 23. In response to an explanation of this point in the previous reply, the Office Action asserts that “Kelly teaches that it is old and well-known in the gaming art to provide different game modes in game machines for player variety,” citing to col. 4, lines 28-34 of Kelly. Office Action, Page 3, Lines 1-3. Applicant disagrees. Simply, in Kelly, there is a single game mode with a single objective, namely, to consecutively stack balls in channel 40. Kelly, Col. 5, Lines 46-51.

Column 4, lines 28-34 of Kelly, which is cited in the Office Action, read as follows:

In alternate embodiments, front panel section 12 can include player controls such as a start button which begins a game. Various other types of buttons, switches, and the like can also be included to allow the player of the game to make various selections concerning game play. For example, a player could select a one- or two-player game, a preferred award type, a progressive option, an end game option, etc., using additional controls on front panel 12.

This passage does not describe the ability to select different game modes with different objectives. The player can select a one- or two-player game, but nothing indicates that a one-player game has a different objective than a two-player game. Selecting a preferred award type and choosing to end the game (“end game option”) similarly do not describe or suggest different game modes with different objectives.

The “progressive option” appears to let a player to opt into a progressive bonus situation, in which the player receives bonuses based on the occurrence of certain events, such as filling all of the positions in the channel 40, getting a ball in a particular position of the channel, or achieving a particular score. See, Kelly, Col. 14, Lines 31-43. However, the objective of the game play is still to consecutively stack balls in channel 40.

Dixon does not remedy this deficiency of Kolwicz and Kelly, nor does the Office Action cite it for this proposition. Therefore, Applicants submit Kolwicz, Kelly, and Dixon, either alone or in combination, do not provide for all of the features of independent claim 23. Accordingly,

independent claim 23, and those claims that depend from it, are allowable over Kolwicz, Kelly, Johns, and Dixon at least for the foregoing reasons.

Claim 1

The Office Action also rejects independent claim 1 as obvious over Kolwicz in view of Kelly, and further in view of Dixon. As amended, independent claim 1 recites, in part, that the claimed game includes an “optical detection system to detect which aperture the playing piece passes through, the optical detection system comprising at least two optical detectors, each optical detector located near an associated one of the apertures, and a common optical emitter arranged such that a beam emitted from the emitter is received by the at least two optical detectors.” Similarly, amended independent claim 11 recites, in part, that the “means for detecting which aperture the playing piece passes through, the optical detection system comprising at least two optical detectors, each optical detector located near an associated one of the apertures, and a common optical emitter arranged such that a beam emitted from the emitter is received by the at least two optical detectors.”

These features are similar to features recited in cancelled dependent claims 7 and 16, which were rejected as obvious over Kolwicz and Kelly in view of Dixon and Johns. However, these references fail to teach or suggest these features. To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. MPEP 2143. Accordingly, because the references do not teach or suggest the above described features, these references do not establish a *prima facie* case of obviousness with respect to independent claims 1 and 11, or the claims that depend from them.

More particularly, the January 3rd Office Action states that claims 7 and 16 are rejected “as being unpatentable over Kolwicz and Kelly in view of Dixon as applied above and in view of Johns as applied in the previous Office action.” In the previous Office action, claims 7 and 16 were rejected with the following rationale:

Regarding claims 1, 2, 5-11 and 14-16, Figure 1 of Kolwicz shows a base unit 1, target area 3 and launch area 3. Figures 2 and 4 show actuators 25 to indicate scoring but do not show an electronic controller. However, it would have

been obvious to one of ordinary skill in the art to employ an electronic controller in combination with the Kolwicz targets in view of Kelly who teaches that it is old and well-known in the gaming art to monitor balls, targets and overall game play with electronic controllers. See Kelly's sensor 92 and microprocessor 132 at Figures 3a-4 and column 10, line 4 through column 12, line 48.

June 29 Office Action, page 3, lines 3-13

Presumably, this rationale relies on Kelly to show the claimed optical detection system. However, Kelly does not describe or suggest an optical detection system that detects which aperture a playing piece passes through, much less an optical detection system in which at least two optical detectors are each located near an associated aperture and a common optical emitter is arranged such that a beam emitted from the emitter is received by the optical detectors. Rather, Kelly discloses the use of multiple emitters and multiple detectors, with one of each for each position in channel 40, to detect where a ball is located in channel 40. Kelly, Col. 10, Lines 32-36 ("a number of sensors 92 [] are positioned within the guide walls [and that each sensor 92 includes] an emitter 92a on one side of channel 40 and a detector 92b on the other side of the channel.")

Furthermore, the rationale quoted above provides no motivation for modifying the optical detection system of Kelly and incorporating it into the device of Kolwicz to obtain the claimed game. To establish a *prima facie* case of obviousness, there must be a motivation in the prior art to combine or modify the references. MPEP 2143. However, neither Kolwicz or Kelly provide a motivation to modify the optical detector of Kelly and incorporate it into the device of Kolwicz to obtain the claimed subject matter. Moreover, the Examiner has provided no rationale as to why a skilled artisan would have been motivated to do so, even though "it is the duty of the Examiner to explain why combination of the reference teachings is proper." *Ex parte Skinner*, 2 U.S.P.Q.2d 1788, 1790 (B.P.A.I. 1987).

Therefore, Applicants submit that Kolwicz, Kelly, and Dixon, either alone or in combination, do not describe or suggest all of the features of independent claims 1 and 11. Accordingly, independent claims 1 and 11, and those claims that depend from them, are allowable over Kolwicz, Kelly, and Dixon at least for the foregoing reasons.

Claim 29

The Office Action rejects independent claim 29 as obvious over Kolwicz in view of Kelly, and further in view of Dixon. Applicant submits that none of these references describe or suggest a game in which “a playing piece . . . passes unimpeded through [a] corresponding aperture of [a] target section directly into [a] passage common to the apertures,” and “an optical detection system to detect which aperture the playing piece passes through to enter the passage common to the apertures,” as recited in claim 29.

Kelly does not even describe or suggest a playing piece passing through an aperture. See Kelly in its entirety. In Kolwicz, the balls pass into separate channels as a means of keeping score. Kolwicz, col. 3, lines 30-36. In Dixon, the balls passing into apertures 86 are impeded by the mechanical target strike sensors 38. Dixon, col. 3, lines 16-20. Thus, none of these references describe or suggest a game in which the playing pieces pass through an aperture unimpeded into a passage common to the apertures of the game, and a optical detection system to detect which aperture the playing piece passes through to enter the passage common to the apertures.

Such a combination generally may be advantageous, for example, because it removes the need for individual scoring channels behind the apertures, while at the same time preventing the disadvantages of using mechanical strike sensors at the aperture. Using individual channels such as those described in Kolwicz add manufacturing costs and mechanical complexity to the design and manufacture of the game. On the other hand, using mechanical target strike sensors at the aperture, as shown by Dixon, may cause the balls to bounce back out of the aperture, instead of passing through the aperture. These disadvantages may be eliminated by allowing the playing piece to pass unimpeded through an aperture to a passage common to the apertures, and using an optical detection system to detect which aperture the playing piece passed through.

Applicant submits that claim 29, and those claims that depend from it, are allowable over Kolwicz, Kelly, and Dixon. Accordingly, Applicant requests that the rejection of these claims be withdrawn.

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Enclosed is a \$910.00 check for the Petition for Extension of Time fee and Request for Continued Examination fee. Please apply any other charges or credits to deposit account 06-1050.

Respectfully submitted,

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